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Filing date: **04/27/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92066968
Party	Defendant Software Freedom Conservancy
Correspondence Address	PAMELA S CHESTEK CHESTEK LEGAL P O BOX 2492 RALEIGH, NC 27602 UNITED STATES Email: pamela@chesteklegal.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Pamela S Chestek
Filer's email	pamela@chesteklegal.com
Signature	/Pamela Chestek/
Date	04/27/2018
Attachments	Motion for Leave to Amend Answer.pdf(487633 bytes ) Amended Answer redline.pdf(34291 bytes ) Amended Answer signed.pdf(471529 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4212971  
Mark: SOFTWARE FREEDOM CONSERVANCY  
Registration date: September 25, 2012

Software Freedom Law Center  Petitioner,  v.  Software Freedom Conservancy  Registrant.
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Cancellation No. 92066968

**MOTION FOR LEAVE TO AMEND THE ANSWER**

Registrant Software Freedom Conservancy, by its counsel, moves to amend its Answer. The Board previously denied a motion for summary judgment that Registrant filed because Registrant failed to set forth allegations of conduct on the part of Petitioner that would support Registrant's pleaded affirmative defenses of laches, acquiescence, estoppel, and unclean hands.<sup>1</sup> The Registrant therefore amplifies the affirmative defenses in the Amended Answer. A red-lined proposed Amended Answer and a signed clean copy of the proposed Amended Answer are attached.

Argument

Pursuant to Fed. R. Civ. P. 15(a), the Board should freely grant leave to amend pleadings when justice so requires. TBMP § 507.01(a)(2). The Board may deny a motion if allowance of

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<sup>1</sup> Order, 8 TTABVUE 2.

the amendment would cause undue prejudice to the non-moving party or if it would be futile. See *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971). In other words, the Board must consider whether there is any undue prejudice to the non-moving party and whether the amendment is legally sufficient.

### Undue Prejudice

In determining whether the other party would be prejudiced by allowance of the proposed amendment, the timing of the motion for leave to amend plays a large role. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). The Board may also consider bad faith or dilatory motive and whether the party has previously amended its pleadings. *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016).

This motion is brought very early in the proceeding. The cancellation has not yet advanced beyond the pleading stage<sup>2</sup> and discovery has not yet started. Since the amended pleading is an Answer, and the only changes are to the affirmative defenses, no responsive pleading is required. Petitioner is therefore not prejudiced by the very short delay that amending the Answer may cause.

This is the first amendment to the Answer. Registrant has not been dilatory; its motion to amend is filed only one day after the Board denied the Petitioner's previously pending motion to

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<sup>2</sup> Order, 13 TTABVUE 8-9 (resetting trial dates starting with initial disclosures, which are due on May 25, 2018).

amend its Petition to Cancel, which is when the proceedings resumed and new motions could be filed.

Legal Sufficiency of Amendment

As noted, the amended answer amplifies the affirmative defenses that were previously described in a more cursory manner. The defenses now include sufficient detail that Petitioner is on “fair notice” of the basis for the defenses.<sup>3</sup> *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). The proposed amendment is therefore legally sufficient.

Registrant therefore asks that the Board GRANT the Motion for Leave to Amend the Answer.

Respectfully submitted,

Dated: April 27, 2018

By:  \_\_\_\_\_  
Pamela S. Chestek  
Chestek Legal  
PO Box 2492  
Raleigh, NC 27602  
Attorney for Registrant  
[pamela@chesteklegal.com](mailto:pamela@chesteklegal.com)

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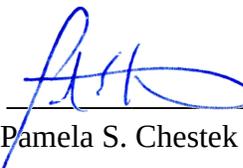
<sup>3</sup> Of course, Petitioner has already seen the Registrant’s Motion for Summary Judgment, so it has an understanding of the facts and argument for the defenses far beyond what is required for an Answer.

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Amended Answer has been served on Software Freedom Law Center by mailing said copy on April 27, 2018, via electronic mail to:

Daniel Byrnes  
Software Freedom Law Center  
435 West 116th Street  
New York, NY 10027

Email: [dbyrnes@softwarefreedom.org](mailto:dbyrnes@softwarefreedom.org)

By:  \_\_\_\_\_  
Pamela S. Chestek

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Cancellation No. 92066968

**AMENDED ANSWER**

Registrant Software Freedom Conservancy, by its counsel, responds as follow to the Petition to Cancel:

1. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 1 of the Petition to Cancel and therefore denies the same.
2. No response required. The registration speaks for itself.
3. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 3 of the Petition to Cancel and therefore denies the same.
4. Denied.
5. Denied.
6. Denied.
7. Admitted.
8. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 8 of the Petition to Cancel and therefore denies the same.
9. Admitted.

10. Admitted, except that the Registrant's certificate of incorporation was filed on March 20, 2006 and was accepted and sealed by the New York Department of State on April 7, 2006.
11. Admitted.
12. Admitted.
13. Admitted.
14. Admitted, except that Mr. Kuhn became Executive Director on October 1, 2010.
15. Admitted.
16. Admitted.
17. No response is required. There is no allegation in Paragraph 17.
18. Denied.
19. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 19 of the Petition to Cancel and therefore denies the same.
20. Denied.
21. Denied.
22. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 22 of the Petition to Cancel and therefore denies the same.
23. Denied.
24. Denied.
25. Admitted.
26. Admitted.
27. Admitted.
28. Admitted.
29. Admitted.
30. Admitted.

31. Admitted.

32. Admitted, except that the statement was made by the signatory, not the Registrant.

### **AFFIRMATIVE DEFENSES**

1. The Petition for Cancellation ~~Petitioner's claim~~ fails to state a claim upon which relief can be granted.

2. Petitioner created Registrant in 2006, chose its name, provided legal services to Registrant for many years, and routinely interacted with Registrant from its inception until the present. At no time between the publication of Registrant's trademark on July 10, 2012 and the date of the Petition for Cancellation, November 22, 2017, did Petitioner object to Registrant's registration of SOFTWARE FREEDOM CONSERVANCY. Registrant changed its economic position during that period by expending significant resources to expand its trade and accrue significant goodwill in the mark. Petitioner's claim is therefore barred by the doctrine of laches.

3. Petitioner has affirmatively promoted and encouraged Registrant's activities from its inception until the present, including inviting Registrant's personnel to speak at its events. As recently as May, 2016 the Executive Director of Petitioner stated expressly that he had no complaints against Registrant. Petitioner's claim is therefore barred by the doctrine of acquiescence.

4. At no time between the publication of the Registrant's trademark on July 10, 2012 and the date of the Petition for Cancellation, November 22, 2017, did Petitioner object to Registrant's registration of SOFTWARE FREEDOM CONSERVANCY. Registrant relied on Petitioner's silence as indicating that Petitioner did not object to Registrant's use and registration of its mark. Registrant changed its economic position during that period by expending significant resources to expand its trade and accrue significant goodwill in the mark. Petitioner's claim is therefore barred by the doctrine of equitable estoppel.

5. The Executive Director of Petitioner affirmatively stated in May, 2016 that he had no complaints against Registrant, only its employees. He subsequently stated on or about November 22, 2017, after the petition to cancel was filed, that he expects the Registrant to be able to continue to use its mark. Therefore, the Petition to Cancel was not filed because of any trademark concern, but as a misuse of legal process to harass individuals for unrelated perceived wrongs. Petitioner's claim is therefore barred by the doctrine of unclean hands.

6. Registrant is a former client of Petitioner. The same lawyers at Petitioner who represented Registrant are now acting as lawyers for Petitioner, adverse to Registrant in a matter substantially related to the work the Petitioner performed for Registrant, namely, the formation and naming of Registrant. Petitioner's claim is therefore barred by the doctrine of unclean hands.

~~1. Petitioner's claim is barred by the doctrine of unclean hands.~~

~~2. Petitioner's claim is barred by the doctrine of laches.~~

~~3. Petitioner's claim is barred by the doctrine of estoppel.~~

~~4. Petitioner's claim is barred by the doctrine of acquiescence.~~

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WHEREFORE, Applicant prays that the Petition to Cancel be dismissed and that judgment be entered in favor of Registrant against Petitioner.

Respectfully submitted,

Dated: April 27, 2018

By: \_\_\_\_\_

Pamela S. Chestek  
Chestek Legal  
PO Box 2492  
Raleigh, NC 27602  
Attorney for Registrant  
[pamela@chesteklegal.com](mailto:pamela@chesteklegal.com)

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Amended Answer has been served on Software Freedom Law Center by mailing said copy on ~~November 2, 2017~~ April 27, 2018, via electronic mail to:

Daniel Byrnes  
~~Software Freedom Law Center~~  
~~1995 Broadway, 17th Floor~~  
~~New York, NY 10023~~  
Software Freedom Law Center  
435 West 116th Street  
New York, NY 10027  
Email: [dbyrnes@softwarefreedom.org](mailto:dbyrnes@softwarefreedom.org)

By: \_\_\_\_\_  
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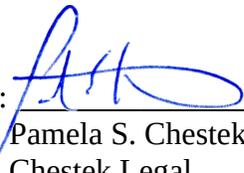
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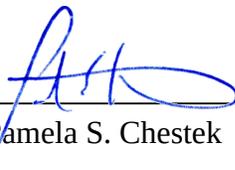
Dated: April 27, 2018

By:   
\_\_\_\_\_  
Pamela S. Chestek  
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Attorney for Registrant  
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By:  \_\_\_\_\_  
Pamela S. Chestek